At the outset, the Examiner continues to demonstrate a remarkable disregard for the explicit claim language that explicitly requires converting the text-based message of an SMS message into an audible message ***in response to detecting the text-to-speech messaging command within the SMS message***. For example, claim 1 specifies:

1. (ORIGINAL) A method in a server configured for executing messaging operations, the method comprising:

receiving a short message service (SMS) message ***that specifies a text-to-speech messaging command***, a text-based message, and a messaging destination;

detecting the text-to-speech messaging command during parsing of the SMS message;

invoking a text-to-speech resource for conversion of the text-based message into an audible message in response to detecting the text-to-speech messaging command; and

outputting the audible message for delivery to the messaging destination.

The Examiner is correct on page 7 that "previous arguments were more specific than this example": the advantage that originator of the SMS message can request conversion of the text-based message into an audible message, regardless of message type preferences for the messaging destination, ***is*** in fact a claimed property based on the claimed operations (in claims 1, 20, and 31) of "invoking a text-to-speech resource for conversion of the text-based message into an audible message ***in response to detecting the text-to-speech messaging command***; and ***outputting the audible message*** for delivery to the messaging destination." (Claim 12 specifies the SMS command processor "invoking the text-to-speech resource ... ***in response to detecting the text-to-speech messaging command*** [in the parsed SMS message]"). No further steps are required to determine whether text-to-speech should be performed: destination subscriber delivery preferences need not be ascertained upon receipt of the SMS message, nor is any interactive messaging session required between the originator of the SMS message and a unified

messaging server, where the originator would transfer the SMS message, ***and*** select a delivery option during the interactive messaging session to request text-to-speech translation of the SMS message.

Rather, the claims ***explicitly specify*** that the text-to-speech (TTS) resource ***is invoked in response to*** the detection of the text-to-speech messaging command ***within the SMS message***. To assert that "the argument concerning *regardless* of message type preferences for the messaging destination is not claimed" defies logic and ignores the explicit claim limitations.

As stated in MPEP § 2141.02 on page 126:

> In determining whether the invention as a whole would have been obvious ... we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question ... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification."

(Quoting In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) (emphasis added).

Hence, the feature that the TTS resource is invoked in response to the detection of the TTS messaging command within the SMS message cannot be disregarded, and the claimed structures and methods cannot be divorced from the problems addressed by the inventor and the benefits resulting from the claimed invention. In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

As admitted in the Official Action, Schwelb does not disclose or suggest: (1) receiving an SMS message that specifies a text-to-speech messaging command; (2) detecting the text to speech messaging command during parsing of the SMS message; (3) invoking a text to speech

resource for conversion of the text-based message into inaudible message in response to detecting the text to speech messaging command. Rather, col. 5, lines 47-52 specify that the decision for performing text-to-speech conversion is based on subscriber attribute information (e.g., a non_seeing subscriber (NSS) field) that specifies that the subscriber has activated a feature for automatic text-to-speech operations.

Jones does not teach "receiving a message that specifies a text to speech messaging command (column 8, lines 51-59)", as asserted in the Official Action. In fact, the cited portion of Jones actually teaches that a sender ***instructs*** the ***message delivery service*** on the manner in which the message should be delivered:

> When the sender knows the preferred media format for the recipient of the message, the *sender* can instruct the *message delivery service* to put ***the message***, composed in one format, into the preferred format when technically feasible. For example, the message may be composed as text, and converted to voice using speech synthesis. As will be appreciated, the preferred media format for a message recipient can usually be determined from a query to the network directory service. Certain message preparation services are capable of automatically querying the directory service and using the query results for format conversion.
>
> (Col. 8, lines 50-61).

Also note in Figure 2 of Jones that the sending entity 500 is distinct from the message composition service 710 and the message delivery service 720:

> A sending entity 500 communicates with the message composition service 710 ***to compose a message***. Message composition may include interaction with the directory service 700. The sending entity 500 then instructs the message composition service 710 to ***transfer the composed message to the message delivery service 720***, which delivers the message to its specified destination and provides various forms of reports on delivered messages to the sending entity 500.
>
> (Col. 12, lines 9-17).

As shown in the above-quoted portion of col. 8, lines 50-61, Jones contemplates that the sending entity 500 interacts separately with the message composition service 710 and the message delivery service 720.

Hence, there is no disclosure or suggestion of receiving a message that specifies a text-to-speech messaging command, as asserted. Rather, one having ordinary skill in the art, upon having reviewed Jones, would at most conclude that a subscriber may transfer a message, for example using a unified messaging interface session, and the subscriber ***also*** may send an instruction during the unified messaging interface session that specifies that the message should be converted to speech.

Hence, Jones simply teaches that a sender of the message can also send a text to speech instruction that is distinct from the message. There is no disclosure or suggestion that the message actually ***includes*** the text to speech instruction, as claimed. Further, there is no evidence of any desirability by one skilled in the art to modify either Schwelb or Jones, singly or in combination, to actually ***insert the TTS command within the SMS message itself***: all the applied teachings of SMS messaging (of Schwelb) and messaging in general (of Jones) specify that attributes and commands associated with messaging delivery are kept separate from the actual message. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990).

Hence, the hypothetical combination of Schwelb and Jones would disclose no more than

a sender, during an interactive unified messaging interface session, being able to transfer an SMS message with a separate delivery instruction that requests text-to-speech translation.

The Examiner continues to offer an ill-founded and futile attempt to salvage Luther as analogous prior art. The Examiner first argues in paragraph 9 on page 8 that "the common field of Schwelb et al., Jones and Luther is text-to-speech ***messaging***" (emphasis added), followed by the assertion in paragraph 10 that "Luther has not been applied for showing transfer of SMS messages, but for showing detecting the text-to-speech messaging command during parsing of ***the message*** and conversion to audible message in response to the detecting step" (emphasis added).

The assertion that Luther has anything to do with any messaging is ill-founded: there is no reference whatsoever to ***any type of messaging*** being performed in Luther; in fact, Luther does not provide a single recital of any of the terms, "messaging", "messages", "mail", "sender", "sending party", "deliver", all fundamental terms for use in describing ***messaging*** operations.

In fact, the sole reference to the term "message" in Luther is on col. 8, line 17, part of an Appendix specifying ***scripting commands*** for a multimedia script file and that describes a command for generating a prompt message for a user:

> laskUserYN:
> {question text}, {if yes goto
> tag name, {if no goto} tag name.vertline.
> ***Present question to user in a message box with yes and no buttons***.

Luther amply demonstrates that the his teachings of multimedia presentation have

absolutely nothing to do with ***messaging*** (i.e., sending a message from a sender to a destination):

> The present invention relates to a system for scripting a text-to-speech-based multimedia presentation, and in particular, to a system in which a scripting file which includes text narration and multimedia commands is processed so as to separate the text from the commands, to enunciate the text narration, and to execute the multimedia commands.
>
> 2. Description Of The Related Art
>
> Recently, the sophistication of computerized multimedia presentations has increased dramatically. Such presentations include audio programs, such as MIDI ("musical instrument digital interface") music and digitized speech, and video programs which may include bit map still video images and digitized motion video or animated features. The audio program and the video program are scheduled into a combined multimedia presentation.
>
> Conventional scheduling systems for the audio program and the video program in multimedia presentations are time/event-based scheduling systems in which each program (or event[)] is scheduled to begin and end at pre-designated times. Thus, for example, ***FIG. 7 shows a system for scheduling a multimedia presentation which includes MIDI music, digitized audio speech, still video, and digital motion video programs. Each aspect of the program is scheduled to begin and end at specifically noted times as set forth on the time line for each program***. Thus, for example, the multimedia presentation begins with a still video presentation of a "credits" file, and a MIDI music presentation synthesized from an "intro" file. At thirty seconds into the multimedia presentation, digitized speech is scheduled to begin a voice-over sequence that plays out at the same time as the synthesized MIDI music. Meanwhile, the still video "credits" file is closed out and a digitized motion video sequence from an "introduction" file commences. ***Scheduling of the multimedia presentation continues in accordance with the illustrated time line.***

Fig. 7 of Luther demonstrates that multimedia presentations cannot be used at all in the messaging systems of Schwelb or Jones. There is no commonality whatsoever between the messaging systems of Schwelb and Jones and the multimedia system of Luther, and there certainly is no commonality between the claimed messaging system and the multimedia system of Luther. Luther is neither in the field of applicant's endeavor, nor reasonably pertinent to the

particular problem with which the inventors was concerned, and as such is non-analogous art. In re Wood, 202 USPQ 171, 174 (CCPA 1979). In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

In fact, the proposed modification to the combination of Schwelb and Jones to include Luther would render the hypothetical combination **unsatisfactory for its intended purpose** of providing SMS messages, because a user could no longer use his or her cell phone for the intended purpose of SMS (***Short Message*** *Service*) messaging: a user would be required to use an advanced computer system in order to create and execute a multimedia script file that synchronizes sound/voice with images/video. This synchronization in the hypothetical combination would be explicitly required due to the Examiner's assertion that one skilled in the art would modify Schwelb "in order to avoid desynchronization as suggested by Luther" (page 3, line 8).

Therefore, the rejection must be withdrawn because "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP § 2143.02, Rev. 2, May 2004 at p. 2100-132 (Citing In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Id. (Citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Cf. MPEP §2145.III at page 2100-160 (Rev. 2, May 2004) ("the claimed combination cannot change the principle of operation of the primary reference or render

the reference inoperable for its intended purpose.").

Further, the Examiner's continued reference of Ex parte Obiaya is nonresponsive to Applicant's arguments that the hypothetical combination does not show or suggest explicit claim limitations. The Examiner's boilerplate language regarding "advantages which would flow naturally" is vague, nonresponsive, and disregards the explicit claim language.

For these and other reasons, the §103 rejection in view of Schwelb et al., Jones, and Luther should be withdrawn.

Claims 6, 9-11, 13, 15, 17-19, 25, 28-30, 36, and 39-41 stand rejected under 35 USC §103 in view of Schwelb et al., Jones, Luther, and U.S Patent No. 6,665,378 to Spielman et al. Applicant appreciates the Telephonic Interview by the Examiner with the undersigned on July 6, 2005, during which the Examiner agreed that a printout from the USPTO Assignment Branch website evidencing recordation of an Assignment of Spielman et al. to Cisco Technology, Inc. would overcome the rejection.

Attached as Exhibit A is a July 6, 2005 printout from the PTO Assignment branch indicating that an Assignment recorded at Reel/Frame 011253/0001 on October 26, 2000 assigned the application 09/629,053, filed July 31, 2000 (and having issued as U.S. Patent No. 6,665,378 to Spielman et al.) to Cisco Technology, Inc.

Hence, Exhibit A establishes the common ownership of USP 6,665,378 to Spielman et al. and the subject application; consequently, USP 6,665,378 to Spielman et al. is not available as a reference under 35 USC §103(c). See MPEP §706.02(l)(2)(II)(A).

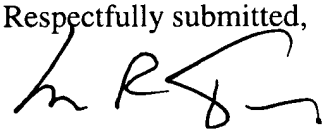
Claims 2, 21, 32, and 42 stand rejected under 35 USC § 103 in view of Schwelb et al.,

Jones, Luther, and US Patent Application Publication 2003/0078989 by Ladd. It is believed these claims are allowable in view of the foregoing.

In view of the above, it is believed this application is and condition for allowance, and such a Notice is respectfully solicited.

To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a), to Deposit Account No. 50-1130, under Order No. 95-460, and please credit any excess fees to such deposit account.

Respectfully submitted,



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Patent Assignment Details

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Reel/Frame: 011253/0001 **Recorded:** 10/26/2000 **Pages:** 5

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Title: IP-BASED NOTIFICATION ARCHITECTURE FOR UNIFIED MESSAGING

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Exhibit A to Response filed September 16, 2005, Appln. No. 09/846,225